



**GOVERNMENT OF PUERTO RICO**  
DEPARTMENT OF STATE



December 23, 2022

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San Juan, PR 00917

**SUBJECT MATTER**  
**MARK**  
**CLASS**  
**FILING NUMBER**  
**FILING DATE**  
**APPLICANT**

**Office Action**  
**P-AVANZADO**  
**001**  
**248476-01-0**  
**June 22<sup>nd</sup>, 2022**  
**Yara International ASA**

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- ☐ 1. Clearly state the goods and/or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.
- ☐ 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
- ☒ 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.

**DISCLAIMER:**

Applicant must disclaim the wording "AVANZADO" in the mark because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services, and thus is an unregistrable component of the mark. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)). The wording "AVANZADO" is merely laudatory and descriptive of the alleged merit of applicant's goods.

"Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services]." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d at 1256, 103 USPQ2d at 1759 (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)). Thus, wording such as "ultimate," "best," "greatest," and the like are generally considered laudatory and descriptive of an alleged superior quality of the goods and/or services. See *In re Nett*

*Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re The Boston Beer Co.*, 198 F.3d at 1373-74, 53 USPQ2d at 1058-59.

The PRTO can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. The PRTO can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the PRTO may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. Consequently, the following disclaimer must be added:

- **“No claim is made to the exclusive right to use “AVANZADO” apart from the mark as shown.”**

- ☐ 6. The registration for the applied mark is refused on the following grounds:
- ☐ 7. Other.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

**Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. Please select “RESPUESTA A NOTIFICACION” from the dropdown menu. The cost of said filing is \$15.00. If any questions should arise, you can contact the Examining Attorney at [jtorres@estado.pr.gov](mailto:jtorres@estado.pr.gov) or [marcas@estado.gobierno.pr](mailto:marcas@estado.gobierno.pr)**

Cordially,



José M. Torres, Esq.  
Examining Attorney  
Puerto Rico Trademark Office